



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,567	10/17/2003	Kazuo Okada	3022-0022	8957
70432	7590	07/23/2007	EXAMINER	
ALFRED A. STADNICKI 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209			LANEAU, RONALD	
			ART UNIT	PAPER NUMBER
			3714	
			NOTIFICATION DATE	DELIVERY MODE
			07/23/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

AStadnicki@antonelli.com
kleibin@antonelli.com
alfred.a.stadnicki@gmail.com

Office Action Summary	Application No.	Applicant(s)	
	10/686,567	OKADA, KAZUO	
	Examiner	Art Unit	
	Ronald Laneau	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 April 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 16-27 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

Response to Amendment

1. The amendment filed on 4/20/07 has been entered. New claims 16-27 are added and claims 1-27 are now pending.

Election/Restrictions

2. Newly submitted claims 16-27 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 16 discloses a method for setting a value associated with an award obtainable based on a total game result from a first game result from a first machine and a second game result from a second machine and setting the value based on the total game result.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16-27 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

3. Claims 1-27 are objected to because of the following informalities:

Applicants are reminded that functional recitation(s) using the word “**for**” (e.g. “**for use**”, “*a first game machine for... a specification value setting device for...a transmitting device for...* a gaming machine determining device for... a total result data receiving device for... a specification value determining for... a specification value renewing for...” etc. as recited in claims 1-27) have been considered but given less patentable weight because they fail to add any

steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method and system claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.). If Applicant(s) desire to give the phrase greater patentable weight, the Examiner respectfully recommends Applicant(s) remove "for use". Like always, such modification(s) must not constitute new matter and be supported in Applicant(s)' specification.

To overcome the rejection, Applicant is required to remove the "for" language and replace it by "that." For example: "*a first game machine that transmits/receives*"... *and so on...*

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US 6,110,041).

As per claims 1, 4, 8, 11, and 15, Walker discloses a first gaming machine for transmitting/receiving data to/from a server (see fig. 1), comprising: a specification value setting device for setting at least one specification value as a control condition for game control (see fig.

3, 330; a controller saves the value setting in the memory); a transmitting device for transmitting data of a game result to the server (col. 3, line 65 to col. 4, line 5); a gaming machine determining means for determining a second gaming machine operated by a co-player (fig. 3, 334 or 335); a total result data receiving device for receiving from the server data of a total game result achieved by the first gaming machine and the second gaming machine based on the data of the game result transmitted by the transmitting means (see fig. 3, results form playing game in reels 332, 334, 336 are being transmitted using the network of fig. 1); a specification value determining device for determining the specification value based on the data of the total game result received by the total result data receiving means (see figs 11a-b; games are played based on player preferences or specification or using the casino preferences or specifications); a specification value renewing device for renewing the specification value set by the specification value determining means to the specification value determined by the specification value determining means (col. 8, lines 41-51; player can input new values or the machine will transmit the casino preference as the new values). Walker does not explicitly disclose that the games are jointly being played but it would have been obvious to one of ordinary skill in the art to jointly play the games because one would need to receive data from both games being played so as to set the specification value for the next game.

As per claims 2 and 9, the system of Walker is capable of determining a plurality of gaming machines including the second gaming machine (see fig. 3).

As per claims 3 and 10, Walker discloses a first gaming machine wherein the total result data receiving means receives from the server the data of the total game result and wherein the total game result is achieved by the plurality of gaming machines including the first and the

second gaming machines (see fig. 3, results from playing game in reels 332, 334, 336 are being transmitted using the network of fig. 1).

As per claim 5, walker discloses a first gaming machine (332) wherein the gaming machine determining means determines a plurality of gaming machines including the second gaming machine (334) and wherein the first gaming machine transmits and receives data to and from the plurality of gaming machines (see fig. 3, data are transmitted between gaming reels through controller 330).

As per claim 6, Walker discloses a first gaming machine wherein the receiving means receives data of game results achieved by the plurality of gaming machines including the second gaming machine and wherein the game result totalizing means totalizes a game result achieved by the first gaming machine and the game results achieved by the plurality of gaming machines including the second gaming machines based on the data of the game results of the plurality of gaming machines received by the receiving means so as to calculate the total result (see fig. 3, all results from all the reel machines are transmitted using a network).

As per claim 7, Walker discloses a first gaming machine comprising gaming machine selecting means for selecting the second gaming machine based on an operation by a game player, wherein the gaming machine determining means determines the second gaming machine based on a selection result by the gaming machine selecting means (see fig. 3, data are transmitted between gaming reels through controller 330).

As per claim 12, Walker discloses a gaming machine that performs determining at least one gaming machine other than the second gaming machine (see fig. 3, 332, 334).

As per claim 13, Walker discloses a program wherein the computer of the first gaming machine performs receiving from the server data of the total result totalizing a game result achieved by the at least one gaming machine other than the second gaming as well as the game results achieved by the first and the second gaming machines (see fig. 3, results from playing game in reels 332, 334, 336 are being transmitted using the network of fig. 1).

As per claim 14, Walker discloses a first gaming machine wherein the specification value comprises a payout (col. 5, lines 12-14).

Response to Arguments

6. Applicant's arguments filed on 4/20/07 have been fully considered but they are not persuasive.

Applicant argues that each of the independent claim requires "receipt or calculating of data of a total game result achieved by the first gaming machine and the second gaming machine, a determination of a specification value based on the total game result data, and renewing to replace a set specification value with, or transmitting, the determined specification value." In response to Applicant's arguments, most of the limitations in the claims include functional recitations using the word "for" and therefore carry no weight.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ronald Laneau
Ronald Laneau
Primary Examiner
Art Unit 3714

rl

7/17/07